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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,489	03/11/1999	JAY S. WALKER	WD2-98-092	7106
22927	7590	01/08/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/267,489	WALKER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Reagan	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,8-17,21-30,35-42,44 and 47-50 is/are rejected.
- 7) Claim(s) 5-7, 18-20, 31-34, 43, 45, and 46 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the appeal brief received on 11 September 2003.
2. Claims 1-50 have been examined.

### **Response to Arguments**

3. In view of the appeal brief filed on 11 September 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### **Allowable Subject Matter**

4. Claims 5-7, 18-20, 31-34, 43, 45, and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

6. Claims 1-4, 8-12, 14-17, 21-25, 27-30, 35-42, 44, and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435) in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996), in view of Applicant's own admission.

**Claims 1, 27, and 39:**

Sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10-19).

Selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14-15, column 3, lines 4-13 and lines 55-61).

Druckenmiller does not specifically disclose a postal mailing address. However, using a postal address as a correlation to an email address is an obvious choice relative to a demographic profile. In the specification, applicant states, "the subset of list members...can be selected with an eye toward various factors such as the demographics of the particular members, because the postal mailing lists are already compiled based on such factors." Druckenmiller, in column 7, lines 18-22 discloses, "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." It would have been obvious to one of ordinary skill in the art at the time of the invention to use the demographic of a postal mailing address as a selection device for identifying possible mail recipients. Using a postal mailing address geographically identifies a target audience, and is already a well known practice in the targeted marketing practices.

In addition, Druckenmiller does not specifically disclose sending an email message to the member on the list. However, "How to Generate Online Leads from the Web" discloses using postal address mailing lists, sending a questionnaire that includes postal mailing address fields and email address fields, asking recipients to submit their email address, and if they would like to be

added to the mailing list. Naturally, if a recipient responds with correct or updated contact information, either by email or by postal mail, the recipient can be regarded as a verified lead. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Druckenmiller with "How to Generate Online Leads from the Web" because using email to verify postal addresses and to further target recipients provides good leads and increases potential profitability.

With regard to selection of one or a plurality of mailing lists over another, Applicant readily admits that choosing a proper mailing list is crucial (see specification, pages 1-3). Basing that choice on the responses from a email sent out to each member on the list for verification and confirmation of accurate mailing data would be an obvious modification of Druckenmiller and "How to Generate Online Leads from the Web" because, as disclosed by the Applicant, "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece."

**Claim 14:**

The limitations of Claim 14 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 14 recites a processor, database, communication port, and a memory. Druckenmiller discloses a computer and a database in Figure 1.

**Claims 2, 15, 28, and 40:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose selling the mailing lists. Applicant, however, on page 2, line 10 of the specification, discloses a business purchasing a mailing list, inherently disclosing that a mailing list is bought and sold as a marketable item. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then selling the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth.

**Claims: 3, 16, 29, and 41:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 2, lines 8-9 of the specification, discloses that a mailing list may be rented. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then renting the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Renting is an option

to purchasing the list because the accuracy of the list may decrease after a period of time, driving the value of the list downward.

**Claims 4, 17, 30, and 42:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to "mail promotional items such as brochures, advertisements, or sales offers to persons included in the list." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual and groups who may be interested in involving themselves with the organization.

**Claims 8, 35, and 47:**

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

**Claims 9, 36, and 48:**

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

**Claims 10, 37, and 49:**

Mailing list selection based on the answers to the demographic/topic of interest questions (column 6, lines 34-42).

**Claims 11, 21, 34, 38, and 50:**

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

**Claims 12:**

Response to the message is made through a URL (column 2, lines 16-19).

**Claim 22:**

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

**Claim 23:**

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

**Claim 24:**

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

**Claim 25:**

Response to the message is made through a URL (column 2, lines 16-19).

**Claim 44:**

Storing the data concerning the member, such as subscriber information from the subscription form (column 6, lines 42-50).

7. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996), in view of McEvoy et al., United States Patent Number 6,292,785, hereafter referred to as "McEvoy."

**Claims 13 and 26:**

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in column 5, lines 13-27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase participation, thereby increasing the value of the mailing list.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

**Washington, D.C. 20231**

or faxed to:

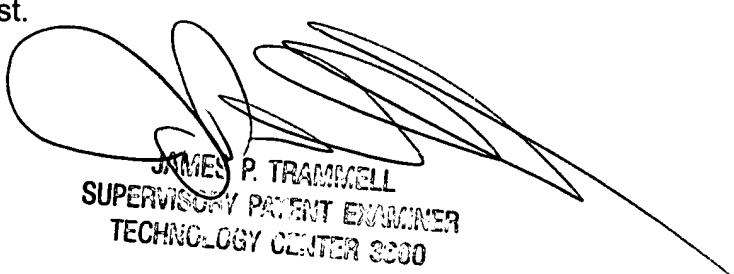
**(703) 305-7687** [Official communications; including  
After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

16 December 2003

  
**JAMES P. TRAMMELL**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**